

REMARKS

This responds to the Office Action mailed on December 1, 2006.

Claims 1, 3-5, 9-19, 21, 22, 24-30, 37-43, and 47 are amended; claims 1-47 are now pending in this application.

§101 Rejection of the Claims

Claims 1-19 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The Office Action rejected claims 1-19 as being directed to the manipulation of an abstract idea that has no apparent concrete result as receiving the transaction request, matching the transaction request with property profiles and providing a transaction request do not result in an actual transformation of information or the performance of an actual transaction.

It has long been established that software implementations including programs and codes embodied in a computer media are inventions that are entitled to patent protection and thus are considered patentable subject matter. (*In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (*en banc*)). In fact, if a claimed invention as a whole produces a useful, concrete and tangible result, then the invention is patentable. (*State Street Bank & Trust v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998)).

Applicants respectfully submit that "receiving a plurality of property profiles from a plurality of responsible parties . . . and a transaction request . . .", "matching the transaction request . . ." and "providing the transaction request to a subset of the plurality of responsible parties" are concrete (e.g., substantially repeatable), tangible (e.g., the matching the transaction request with the plurality of property profiles is a real-world result) and useful (e.g., providing the transaction request to a subset of the plurality of responsible parties provides a valuable transaction matching function). See MPEP § 2106(IV)(C). Accordingly, Applicants respectfully submit that claims 1-19 fully comport with 35 U.S.C. § 101. As such, Applicants respectfully requests withdrawal of this rejection of these claims.

§103 Rejection of the Claims

Claims 1, 3-10, 12-14, 17-20, 22-25, 27-28, 31-42 and 44-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser (U.S. 5,664,115) in view of Tozzoli et al. (U.S. 5,717,989). Applicants respectfully traverse these rejections.

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness because even if combined, the cited references fail to teach or suggest all of the claim limitations of the independent claims of the present Application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 1 recites:

A method comprising:

- receiving a plurality of property profiles from a plurality of responsible parties;
- receiving a transaction request from a requesting party;
- matching the transaction request with the plurality of property profiles; and
- providing the transaction request to a subset of the plurality of responsible parties having a matched property profile.

Claim 20 recites:

A machine readable medium having stored thereon instructions which when executed by a processor cause the machine to perform operations comprising:

- receiving a plurality of property profiles from a plurality of responsible parties;
- receiving a transaction request from a requesting party;
- matching the transaction request with the plurality of property profiles; and
- providing the transaction request to a subset of the plurality of responsible parties having a matched property profile.

Claim 34 recites:

A computer connected to a network comprising:

a bus;

a storage device coupled to the bus; and

a processor coupled to the bus, the processor to execute software to cause the computer to perform operations comprising:

- (i) receiving a plurality of property profiles from a plurality of responsible parties,
- (ii) receiving a transaction request from a requesting party,
- (iii) matching the transaction request with the plurality of property profiles,
- (iv) providing the transaction request to a subset of the plurality of the responsible parties having a matched property profile, and
- (v) providing an offer received from the subset of the plurality of responsible parties to the requesting party.

Fraser is directed to an interactive computer system to match buyers and sellers of real estate, businesses and other property. See Col 1 lines 7-9. A prospective buyer of Fraser “accesses information regarding each item by searching page by page through the item listing [or] ... can instead input a sorting criteria to select only preferred ones of the property listings [.]”. See Col 6 lines 40-48. “Once [the] prospective buyer's criteria is received, the host system executes a search of all listings in accordance with the input criteria. The prospective buyer then reviews each property listing meeting his or her criteria to determine whether to request more information from the seller.” See Col 6 lines 49-53 (emphasis added). “If such a request is made [], the system then requests information about the prospective buyer, such as name, address, telephone number, available cash, or business experience, as well as the identification numbers of each property listing for which additional information is requested.” See Col 6 lines 53-58.

Fraser does not teach “receiving a transaction request from a requesting party” or “matching the transaction request with the plurality of property profiles” as recited in claims 1, 20 and 34 because the information received from the buyer in Fraser is a search request for the system to perform a search to identify property listings for the buyer. See Col 9 lines 8-19. The search request of Fraser is not a transaction request that “sets in motion events that may lead to a resulting transaction” (see page 4 paragraph 12) as the results of the search request information provided by the buyer in Fraser are provided back to the buyer and not to the seller. See Abstract and Col 6 lines 49-53.

The buyer in Fraser reviews the result of the search request information and manually selects from among the results of the search request one or more listings that meet the buyer's criteria. See Col 6 lines 49-53. In addition, "[u]pon receiving the prospective buyer's requests, the brokers or sellers determine which buyer to respond to based on the information provided by the prospective buyer. If a transaction is ultimately consummated, the seller then pays the system operator an appropriate fee in accordance with the aforementioned agreement (in addition to the aforementioned listing fee), thereby maintaining the seller's account in good standing (S111)." See Col 7 lines 11-19 (emphasis added). The selection made by the buyer and provided to the seller in Fraser is for "more information from the seller" and not a transaction request. See Col 6 lines 51-58. The seller in Fraser is only aware that the buyer has expressed a particular interest in one or more property listings of the seller based on the information provided by the system. See Col 7 lines 1-11.

In summary, Fraser involves two separate actions by the buyer to request additional information from a seller. First, the buyer of Fraser must provide input to receive resulting lists. Next, the buyer of Fraser must select the listings to request more information of the seller. Neither of these actions are a transaction request that "sets in motion events that may lead to a resulting transaction" where the match is made with "the plurality of property profiles" and provided to "a subset of the plurality of responsible parties having a matched property profile."

In addition, combining Tozzoli with Fraser by altering Fraser to include providing the transaction request to a subset of the plurality of responsible parties having a matched profile would destroy the stated purpose of Fraser for having "online search capabilities permitting a prospective buyer to select a group of properties based on a set of criteria." Fraser at Col 2 line 67 – Col 3 line 2, Col 3 lines 14-18, Col 4 lines 12-13, and Col 6 lines 40-48. The modification would also render providing an item by item listing of properties for sale unsatisfactory, as the proposed modification would eliminate a purpose of the system to fulfill a buyer's need to review property listings for making a request for additional information regarding the property listing to a seller. Fraser at Col 2 lines 32-42, lines 57-61 and Col 6 lines 49-58. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

With respect to dependent claims 3-10, 12-14, 17-19, 22-25, 27-28, 31-33, 35-42, and 44-47, which depend on claims 1, 20, or 34, Applicants submit that a dependent claim incorporates each of the claim elements of the claim from which it depends. Applicants respectfully submit that claims 3-10, 12-14, 17-19, 22-25, 27-28, 31-33, 35-42, and 44-47, are allowable over the cited reference for at least the reasons stated above and requests the withdrawal of the §103 rejection and allowance of the claims.

Claims 14, 19, 29, 33, 42 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of Tozzoli et al. as applied to claim 1 and further in view of Broerman (U.S. 6,594,633).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Fraser and Tozzoli do not teach or suggest¹ all of the claim elements of claims 14, 19, 29, 33, 42 and 46 and the combination with Broerman does not cure the defect. Therefore, Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claims 14, 19, 29, 33, 42 and 46.

Claims 2, 11, 21, 26 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of Tozzoli et al. and in view of Broerman as applied to claim 1, and further in view of Walker et al. (U.S. 5,884,272).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Fraser and Tozzoli do not teach or suggest all of the claim elements of claims 2, 11, 21, 26 and 39 and the combination with Broerman and Walker does not cure the defect. Therefore, Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claims 2, 11, 21, 26 and 39.

Claims 15-16, 30 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of Tozzoli et al. and in view of Broerman, and further in view of Eggleston et al. (U.S. 6,061,660).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Fraser and Tozzoli do not teach or suggest all of the claim elements of claims 15-16, 30 and 43 and the combination with

¹ The references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Broerman and Eggleston does not cure the defect. Therefore, Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claims 2, 11, 21, 26 and 39.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 636-728-1187 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

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Date March 1, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of March 2007.

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